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**OFFICE OF PETITIONS**

In re Application of  
Leighton, et al.  
Application No. 09/867,141  
Filed: 30 May, 2001  
Attorney Docket No.: 12293:34

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ON PETITION

This is a revised decision on the petition filed on 19 April, 2006, considered as a request to withdraw of the holding of abandonment under 37 C.F.R. §1.137(b).

For the reasons set forth below: the petition as considered under 37 C.F.R. §1.137(b) is  
**GRANTED**.

**BACKGROUND**

A review of the record indicates that:

- Petitioner failed to reply timely and properly to the Notice of Allowance and Fees Due and Notice of Allowability on 11 August, 2005 (as to the Drawing Requirement) with reply due under a non-extendable deadline on or before 14 November, 2005;
- the instant application went abandoned by operation of law after midnight 14 November, 2005;
- the Office mailed the Notice of Abandonment on 17 March, 2006;

- Petitioner filed, *inter alia*, the original petition seeking withdrawal of the holding of abandonment under 37 C.F.R. §1.181 on 27 March, 2006, which was dismissed on 17 April, 2006, because Petitioner alleged that he previously had submitted drawings—on 24 January, 2002—and the Office clearly ignored the fact that there was no need to reply to the 11 August, 2005, drawings requirement, however, Petitioner did not suggest that he—at any time after the mailing of the Notice of Allowance—replied to the drawing requirement set forth by the Examiner in that 11 August, 2005, Office action;
- the instant petition provides fee, reply and statement of unintentional delay.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>4</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

Allegations as to Unintentional Delay

The regulatory requirements are petition, fee, reply, statement/showing of unintentional delay, and—where appropriate—a terminal disclaimer and fee.

Petitioner appears to have satisfied the regulatory requirements.

The instant application is released to Publications Branch to be processed into a patent in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.